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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,665	06/30/2000	KAORU NAKABAYASHI	Q58650	1041

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EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,665

Applicant(s)

NAKABAYASHI ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12, 24-27, 33, 34 and 37-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10, 24, 25, 27, 37, 38, 40-42, 44-46, 48, 50 and 52-54 is/are allowed.
- 6) ☒ Claim(s) 11, 12, 26, 33, 34, 39, 43, 47, 49 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's amendment filed November 3, 2005. Claims 9-12, 24-27, 33, 34 and 37-54 are pending.

Claim Rejections - 35 USC § 101

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 49 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim recites a computer-implemented invention that is defined as a generalized product claiming functionally descriptive material, and as such must reside on a computer readable medium or equivalent. A "computer readable medium" is necessary for the product to be statutory because it allows the functionality of the program to be realized. Not all media necessarily impart functionality to a computer, and thus the mere recitation of a medium recording an image data processing program for causing a computer to execute an image processing is non-statutory because the medium itself is not recited as being *computer readable*.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 12 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,377,359 (Higashio).

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Regarding claim 12, Higashio teaches an image data processing apparatus comprising: a parameter setting unit which sets a parameter representing contents of a predetermined image processing to be executed on image data (column 7, line 64 - column 8, line 25); a data saving unit which saves the image data and the parameter together with relating information (column 8, lines 31-35; column 5, lines 43-54); a data acquiring unit which acquires the image data and the parameter by referring to the relating information (column 5, lines 54-59); and an image processing reproducing unit which obtains image data subjected to the specified image processing based on the acquired image data and parameter (column 9, lines 4-9); wherein the parameter setting unit sets contents of an image processing based on a result obtained by statistically analyzing the image data (column 9, lines 27-35).

Regarding claim 34, Higashio teaches an image data processing method in which a parameter representing contents of a predetermined image processing to be executed on image data is set, the image data and the parameter are saved together with relating information (column 8, lines 31-35; column 5, lines 43-54), and the image data and the parameter are acquired by referring to the relating information (column 5, lines 54-59), and image data subjected to the specified image processing are obtained based on the acquired image data and parameter (column 9, lines 4-9); wherein the image data are statistically analyzed and contents of an image processing are set based on a result of the analysis (column 9, lines 27-35).

These claims were indicated as being allowable in the prior Office action, for the reason that the prior art does not teach or suggest "management of image data on a

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storage device differently from the parameter.” However, it should be noted that neither of these claims, as they now appear, recite this limitation. In fact, claims 12 and 34 correspond to now-canceled claims 13 and 35, which were rejected under 35 U.S.C. 102(e) as being anticipated by Higashio in the Office action mailed October 7, 2003.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 11, 26, 33, 39, 43, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashio in view of U.S. Patent 6,344,907 (Watanabe et al.).

Regarding claim 11, Higashio discloses an image data processing apparatus comprising: a parameter setting unit which sets a parameter representing contents of a predetermined image processing to be executed on image data (column 7, line 64 - column 8, line 25); a data saving unit which saves the image data and the parameter together with relating information (column 8, lines 31-35; column 5, lines 43-54); a data acquiring unit which acquires the image data and the parameter by referring to the relating information (column 5, lines 54-59); and an image processing reproducing unit which obtains image data subjected to the specified image processing based on the acquired image data and parameter (column 9, lines 4-9). Higashio does not disclose relating and saving thumbnail data of the image data together with the parameter. Watanabe et al. disclose the display of thumbnail images along with processing parameters (column 10, line 17 - column 11, line 34; Figs. 8 and 9). Display of the thumbnail images along with parameters inherently requires that the images be saved,

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at least temporarily. One of ordinary skill would have been motivated to provide for the saving of thumbnail images and related parameters, as disclosed in Watanabe et al., in an image data processing apparatus such as disclosed in Higashio, since this limitation enables a user to view a processed image before printing, thereby avoiding waste in printing materials if he/she decides not to produce the image after viewing.

Claims 39 and 43 each omit certain limitations of above-rejected claim 11. The remaining limitations are suggested by the combined teaching of Higashio and Watanabe et al., as related above.

Claim 33 recites steps for performing image processing as recited in above-rejected claim 11. These steps are suggested by the combined teaching of Higashio and Watanabe et al., as set forth above.

Claim 26 recites the above steps for performing image processing, recorded on a computer readable medium for causing a computer to execute the steps. A computer program for performing image processing steps in general, while not taught by Higashio in view of Watanabe et al., would have been an obvious modification to one of ordinary skill in the art, so that the image processing steps may be performed by a computer without requiring specific hardware for performing each of the steps.

Claims 47 and 51 each omit certain steps of above-rejected claim 26. The remaining steps are suggested by the combined teaching of Higashio and Watanabe et al., as related above.

Allowable Subject Matter

8. Claims 9, 10, 24, 25, 27, 37, 38, 40-42, 44-46, 48, 50 and 52-54 are allowed.

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9. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to teach or suggest separate use of sets of parameters depending on a situation of a pixel as recited in claims 9, 24, 37, 41 and 45; or dividing the image data and parameter with a hierarchical structure, as recited in claims 10, 25, 38, 42, 46 and 50; or management of image data on a storage device differently from the parameter, as recited in claims 12, 27, 34, 40, 44, 48 and 52-54.

Response to Arguments

10. Applicant's arguments, see page 16 of the current amendment, filed November 3, 2005, in response to the prior rejection of claims 24-27 and 45-52 under 35 U.S.C. 101 have been fully considered but they are not entirely persuasive. Applicant states that the claims have been amended to overcome the rejection. However, claim 49 has not been amended, and thus the rejection of this claim is maintained.

11. Applicant's arguments, see page 16 of the current amendment, with respect to the rejection of claims 40, 44, 53 and 54 have been fully considered and are persuasive. The rejection of these claims has been withdrawn.

12. Applicant's arguments filed in response to the prior rejection of claims 11, 26, 33, 39, 43, 47 and 51 under 35 U.S.C. 103(a) have been fully considered but they are not persuasive. Applicant states that Watanabe merely discloses the existence of thumbnail data, but there is no disclosure of saving the image data and the parameter together with relating information. Contrary to applicant's argument, Watanabe discloses display of thumbnail images along with processing parameters (column 10, line 17 - column 11, line 34; Figs. 8 and 9). The display of thumbnail images AS1-AS4 and parameters

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(normal, slenderize, broaden, mirror-image reversal (Fig. 8); 125%, 150%, 175%, 200% (Fig. 9)) is clearly shown, and this meets the requirement of relating and saving thumbnail data of the image data together with the parameter, as recited in the rejected claims. As mentioned above, display of the thumbnail images along with parameters inherently requires that the images be saved, at least temporarily.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

It should be noted that the above rejection of claims 12 and 34 is not a new rejection. These claims, as mentioned above, correspond to now-canceled claims 13 and 35, which were rejected under 35 U.S.C. 102(e) in a prior Office action. The claims have thus been twice rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-

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7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
January 19, 2006